

Attorney Docket No.

DEX-0180

Inventors:

Roberto A. Macina

Serial No.:

09/806,302

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1-10 have been subjected to a Restriction Requirement as follows:

Group I, claims 1-6, drawn to methods comprising measuring levels of ESBPIII; and

Group II, claims 7-10, drawn to methods of imaging or treating comprising administering in antibody than binds ESBPIII. The Examiner suggests that the Groups I and II do not relate as a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. Specifically, the Examiner suggests that the invention groups use different products.

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Applicant respectfully traverse this Restriction Requirement.

At the outset, it is respectfully pointed out that the Examiner's suggestion that "the inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature" directly contradicts the International Preliminary Examination Report issued by this same Examiner in the PCT application of which this case is the U.S. National Stage.

Further, MPEP §803 provides two criteria which must be met for a restriction requirement to be proper. The first is that

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the inventions be independent or distinct. The second is that there would be a serious burden on the Examiner if the restriction is not required. A search of the prior art relating to pending claims 1-10 has already been performed by this Examiner in the PCT application. Thus, there is clearly no burden placed upon the Examiner by including all claims in this case, since the full claim set was already searched and examined by the Examiner in the PCT application.

Accordingly, since this Restriction Requirement does not meet both criteria as set forth in MPEP § 803 to be proper, it is respectfully requested that this Restriction Requirement be withdrawn.

In an earnest effort to be completely responsive, however, Applicant elects Group I, claims 1-6, with traverse.

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record.

Respectfully submitted,

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Date: November 1, 2002

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